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EXAMINER

ENATSKY, AARON L

ART UNIT

PAPER NUMBER

3713

DATE MAILED: 08/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/971,993

Applicant(s)

BILYEU ET AL.

Examiner

Aaron L Enatsky

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5-6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 24 and 28 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The means to change all symbols into new symbols, which is considered critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The means to change all symbols is considered critical as Applicant's specification states that altering all existing symbols to new symbols effectively changes the payout [14:0051]. There is no elaboration whether the new symbols will always be the same every time or whether they are randomly selected. Both possibilities, along with other possibilities not mentioned, could greatly affect the game, thus are considered essential to the invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 1 fails to set forth how the interactive symbol is selected for display. Claim 1 in line 5 also does not state whether or not randomly selecting at least one symbol includes the interactive symbol.

Claim 9 fails to set forth how the interactive symbol is selected for display.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6, 8, and 25-27 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent No. 6,517,432 to Jaffe.

***Claim 1, 25-26:*** Jaffe teaches providing a player with a wager opportunity (2:65-66), displaying a randomly generated combination of symbols (3:52), randomly displaying on interactive symbol (Fig. 5), randomly selecting at least one symbol from the combination of symbols (5:13-16), transforming the at least one symbol through interaction with the interactive symbol (Fig. 6).

***Claim 2:*** Jaffe teaches symbol interaction with between the two symbols based upon the predetermined criteria of a random selection (5:13-16). The interaction is shown as a streaker symbol hiding behind a fruit slice (Fig. 6).

**Claims 3 & 8:** The transformation shows a new symbol as a streaker behind a fruit slice. (Fig. 6). The movement of the streaker places the streaker behind the fruit slice creating a perceptible movement relative to each other.

**Claim 4-6:** Jaffe teaches altering a payout of a payline with the display of a different symbol (5:49-6:3). The altered payout is designated as an increased payout (6:1-3).

**Claim 27:** Jaffe teaches an interactive symbol, a "POLICEMAN", chasing at least one of the chosen symbols, "streaker", until the "streaker" is caught (6:13-20 and 6:47-49).

Claims 9-18, 20-21 are rejected under 35 U.S.C. 102(e) as being anticipated by US Pub. No. 2002/0016200 A1 to Baerlocher et al. ("Baerlocher").

**Claim 9:** Baerlocher teaches a game machine that allows a player to make a wager (2:0033), randomly generate a combination of symbols (Fig. 11), display at least one interactive symbol (Fig. 11), provide a player the opportunity to stimulate interaction between at least one interactive symbol and one of the symbol combinations (4:0049-0051), and transform at least one symbol through the interaction (3:0046).

**Claim 10:** Baerlocher teaches allowing a player to select at least one symbol of the combination for interaction (3:0046-4:0051).

**Claim 11:** Baerlocher teaches a player can control orientation and movement of at least one interactive gaming symbol (6:0074).

**Claim 12:** Baerlocher teaches a game of chase and catch between symbols (4:0057).

**Claims 13:** Baerlocher teaches transforming at least one symbol into a different symbol through the interaction (3:0046).

**Claim 14:** Baerlocher teaches transforming symbols into awards (3:0046) and also that catching a symbol could result in an award (6:0070).

**Claim 15:** Baerlocher teaches player selecting movement of a symbol as discussed in claims 9-14 above, wherein the selected movement would ultimately involve selecting at least one symbol from a combination of symbols.

**Claim 16:** Baerlocher teaches transforming at least one symbol into a different symbol through the interaction (3:0046).

**Claim 17:** Baerlocher teaches transforming symbols into awards (3:0046) and also that catching a symbol could result in an award (6:0070).

**Claim 18:** Baerlocher teaches displaying at least one interactive symbol and a combination of symbols in an array (Fig. 11), and displaying at least one symbol of the combination of symbols in a non-arrayed position (Fig. 13).

**Claim 20:** Baerlocher teaches transforming at least one symbol into a different symbol through the interaction (3:0046).

**Claim 21:** Baerlocher teaches transforming symbols into awards (3:0046), which would alter a payout upon display of the different symbol. The symbols are displayed along at least one payline (Fig. 10).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jaffe as applied to claims 1-6, 8, and 25-27, above, and further in view of US Patent No. 6,033,307 to Vancura.

***Claim 7:*** Jaffe teaches the limitations as described above, but does not teach providing a decreased payout. Vancura teaches a gaming machine with various types of payouts that are well known in the art including, positive payouts, negative payouts, multipliers, etc... (Abstract). The various types of payouts are well known in the gaming arts for providing enhanced game enjoyment through exciting anticipation of potential game outcomes. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Jaffe to use the various types of payouts to increase player excitement.

Claims 24 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jaffe as applied to claims 1-6, 8, and 25-27, above, and further in view of Applicant's Admission of Prior Art ("Applicant").

***Claims 24 and 28:*** Jaffe teaches the limitations as described above, but does not teach changing all displayed symbols upon display of a special symbol. Applicant teaches that it is known to modify a playline by changing all symbols on the payline upon the appearance of a special symbol (4:0009-5:0011). This effectively results in a new payout structure. One would be

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motivated to modify Jaffe to use Applicant's teaching of modifying all symbols on a payline to create a new payout structure as this provides players additional excitement through new, potentially increased ways to win. Additionally, Jaffe in view of Applicant does not teach changing all displayed symbols, only all symbols that appear on a payline of a special symbol. However, it long considered well within the capabilities of one of ordinary skill in the art to duplicate functions, whereby changing all displayed symbols would serve to enhance a player's perceived chances to win. As such, the provision of a changing all displayed symbols would enhance player enjoyment with perceived increased ways to win.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baerlocher.

**Claim 19:** Baerlocher teaches the claimed limitations as discussed above, but does not explicitly teach providing an interactive symbol in a non-arrayed position. However, in one embodiment, a chase scene is described (Fig. 11-13). While not explicitly showing an interactive symbol in a non-arrayed position, the non-arrayed position of other symbols is indicative of an interactive and regular symbol in an action, which has both symbols in a non-arrayed position.

Claims 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baerlocher as applied to claims 9-18, 20-21 above, and further in view of GB Patent No. 2,144,644 A to Barrie.

**Claim 22 & 23:** Baerlocher teaches the claimed limitations as discussed above, but does not teach providing a plurality of additional symbols for player selection or wagering the selection for additional selections. Barrie teaches a game machine based on a traditional type



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gaming machine, such as mechanical or video slots (Abstract and 1:1-34). A player is given an opportunity to make selections from a number of displayed objects. The displayed objects can result in a win, lose, or a chance to wager the additional award through another award selection. The selections can be transformed to reveal awards or losses that symbolize a player's selection (1:42-84). One would be motivated to modify Baerlocher to include the additional player selection game as taught by Barrie to further increase a player's feeling of drama (1:38-40) or for the purpose of the art accepted method of providing a player feeling of increased game control. As such, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Baerlocher to use the additional player selection methodology taught by Barrie to increase player excitement and drama by providing a player the feeling of greater control over a change game.

*Citation of Pertinent Prior Art*

US 6,517,432 to Jaffe teaches a gaming machine with a chase and symbol transformation game.

US 6,050,895 to Luciano, Jr. et al. teaches a gaming machine with player dexterity controls for manipulating a non-traditional gaming machine intertwined with a traditional game machine.

US 6,290,600 to Glasson teaches a gaming machine with symbol movement and transformation affecting player payouts.

US 6,251,013 to Bennett teaches a gaming machine with symbol movement and transformation affecting player payouts.

US 6,089,977 to Bennett teaches a gaming machine with symbol movement affecting player payouts.

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US 6,309,300 to Glavich teaches a gaming machine that provides player selectable elements for increased or decreased award generation.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron L Enatsky whose telephone number is 703-305-3525. The examiner can normally be reached on 8-6 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Walberg can be reached on 703-308-1327. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Aaron Enatsky  
August 8, 2003



**MICHAEL O'NEILL  
PRIMARY EXAMINER**